

REMARKS

In the Office Action, Claims 1, 2, 4, 5, 10, 21, 23, 26, 28 and 29 were rejected under 35 U.S.C. § 102(b) as anticipated by Laugier, P., et al., *Ultrasound Images of the OS Calcis: A new Method of Assessment of Bone Status*, 1993 IEEE Ultrasonics Symposium, pp. 989-992 (herein “Laugier”); and Claims 5-9, 11-20, 24, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Laugier in view of U.S. Patent No. 5,840,029 to Mazess.

Claims 21, 24 and 26-28 are amended, and Claim 23 is cancelled. No new matter is presented.

Claims 1, 21 and 29, which are the pending independent claims, were rejected as anticipated by Laugier. The Examiner states that “Laugier teaches both transducers being confocal [focused] transducers,” citing the “Abstract & 991, Left Column” of Laugier. (Office Action, page 2, brackets in original.) This is incorrect, and for at least this reason Laugier fails to anticipate the invention of the pending claims.

It is well settled that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also M.P.E.P. § 2131.

In the Office Action, the Examiner assumes that simply focusing a pair of transducers will make the transducers *confocal* transducers. Rather, for a pair of transducers to be confocal, the transducers must share a foci.¹ Rather than identify where Laugier describes a pair of transducers having a shared foci, the Examiner simply equates “focused” as being the same as “confocal.” This is incorrect, and Laugier fails to disclose the recitation of Claim 1 of *both transducers being confocal transducers*. Moreover, Laugier fails to disclose *determining the at least one bone property* or to otherwise correlate material properties of bone in the images that are obtained.

Accordingly, at least in view of the failure of Laugier to disclose either of the recitations

¹ As explained in the Specification, “The transducers are configured to receive the bone sample therebetween such that the confocal point of the transducers are located at the at least one point in the bone sample.” Specification, ¶ 0023, as published at US 2005/0283072 A1.

of *both transducers being confocal transducers* or of *determining the at least one bone property* at the point of interest as recited in independent Claims 1, 21 and 29, the rejection must be withdrawn.

Without conceding the patentability *per se* of Claims 2-20, 22 and 24-28, these claims are also allowable at least in view of their dependence upon Claims 1 and 21, respectively.

In addition to the above reasons to withdrawn the rejection, independent Claim 21 has been amended to add subject matter from Claim 23, which formerly depended therefrom and is now cancelled. Like Claim 21, Claim 23 was rejected as allegedly being anticipated by Laugier. The Office Action fails to provide a specific discussion in regard to how the Examiner believes that Laugier discloses each of the recitations Claim 23, which are now presented in Claim 21. For this additional reason the rejection of Claim 21 must be withdrawn.

For the above reasons, the pending claims are believed to be in condition for allowance and issuance of a notice of allowance is respectfully requested. If the Examiner has any questions regarding this communication, the Examiner is requested to contact the undersigned at the below number. Please charge any deficiency or other fee(s) that may become due under 37 C.F.R. § 1.16 and 1.17, at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-4053. Also, if any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 504053 therefor.

Respectfully Submitted,



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